

BESSETTE et al.  
Appl. No. 09/604,082

Atty. Docket No. 4380-107

### **REMARKS/ARGUMENTS**

Claims 4, 19 and 45 are pending. Claims 1-3, 5-18, 20-44 and 46-49 are canceled without prejudice or disclaimer of the subject matter they contain. Solely in an effort to advance prosecution, claims 4, 19 and 45 are amended to encompass infringing subject matter. By the above amendments, no new matter has been added. Applicants do not acquiesce to the propriety of any of the Examiner's rejections and does not disclaim any subject matter to which Applicants are entitled. *Cf. Warner Jenkinson Co. v. Hilton-Davis Chem. Co.*, 41 U.S.P.Q.2d 1865 (U.S. 1997). Applicants reserve the right to file continuing applications to cover disclosed subject matter not encompassed by the currently pending claims.

Entry of the above amendment(s) is proper under 37 C.F.R. § 1.116 because the amendments: (a) places the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout the prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for the appeal. Thus, entry is respectfully requested.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

The Office Action rejects claim 4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,759,930 ("the '930 patent") in the light of evidence by Fehr et al. The Office Action asserts that the '930 patent discloses a method using a pesticidal composition in a form of plant blends or powders comprising rosemary leaves, peppermint leaves and a carrier. In response, Applicants respectfully submit that amended claim 4 does not recite a pesticidal composition comprising a carrier, rosemary oil and peppermint oil. Instead, claim 4 is directed

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to a method of using a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally effective active ingredient consisting of rosemary oil and phenethyl propionate, which is not anticipated by the teachings of the '930 patent or Fehr. Thus, Applicants respectfully submit that this rejection should be reconsidered and withdrawn.

The Office Action rejects claim 4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,759,930 in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. The Office Action reiterates the arguments with respect to the '930 patent and Fehr. In addition, the Office Action asserts that Elamrani discloses that eugenol is present in the rosemary oil or in rosemary plant materials. In response, Applicants respectfully submit that amended claim 4 does not recite a pesticidal composition containing eugenol. Instead, claim 4 is directed to a method of using a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally effective active ingredient consisting of rosemary oil and phenethyl propionate, which is not anticipated by the teachings of the '930 patent or Fehr or Elamrani. Thus, Applicants respectfully submit that this rejection should be reconsidered and withdrawn.

The Office Action rejections Claim 4 under 35 U.S.C. § 102(b) as being anticipated by JP 07145598. The Office Action states that JP 07145598 discloses a method of applying a contact pesticidal composition comprising rosemary oil and peppermint oil and a carrier. The Office Action acknowledges that JP 07145598 teaches the disinfecting effect of applying compositions comprising rosemary oil and peppermint oil. In response, Applicants respectfully submit that amended claim 4 does not recite a pesticidal composition containing rosemary oil and peppermint oil and a carrier. Instead, claim 4 is directed to a method of using a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally effective active ingredient consisting of rosemary oil and phenethyl propionate, which is not anticipated by the

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teachings of JP 07145598, which teaches disinfectant compositions containing eucalyptus oil, peppermint oil, menthol, mint oil, etc. Thus, Applicants respectfully submit that this rejection should be reconsidered and withdrawn.

The Office Action rejects claim 4 under 35 U.S.C. § 102(b) as being anticipated by JP 07145598 in the light of evidence by Elamrani et al. The Office Action states that JP 07145598 is relied upon as explained above and acknowledges that it is silent with regard to eugenol being present in rosemary oil. The Office Action relies on Elamrani for teaching that eugenol is inherently present in the disclosed rosemary oil-containing composition. In response, Applicants respectfully submit that amended claim 4 is directed to methods of using a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally effective active ingredient consisting of rosemary oil and phenethyl propionate, which is not anticipated by the teachings of JP 07145598, which teaches disinfectant compositions containing eucalyptus oil, peppermint oil, menthol, mint oil, etc. Thus, Applicants respectfully submit that this rejection should be reconsidered and withdrawn.

It is noted that amended claim 45 is directed to a method of using a pesticidal composition comprising a pesticidally acceptable carrier and a pesticidally effective active ingredient *consisting of* rosemary oil and peppermint oil, which is not anticipated by any of the references cited against claim 4.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

The Office Action rejects claims 4, 19 and 45 under 35 U.S.C. § 103(a) as being unpatentable over JP 07145598 or US 4,759,930 in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. taken with U.S. Patent Nos. 6,183,767 ("the '767 patent"),

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US 3,761,584 ("the '584 patent") and Ngoh. The Office Action states that JP 07145598 is relied upon for the disclosure of a method of using a contact pesticidal composition *comprising* a carrier, *rosemary oil*, *peppermint oil* and/or *eugenol* in light of Elamrani. The Office Action further states that the '930 patent is relied upon in light of Fehr and in light of Elamrani for the disclosure of a method of using a contact pesticidal composition *comprising* carrier and rosemary oil in combination with peppermint oil and at least some amount of eugenol. In response, Applicant respectfully submits that none of the pending claims recite a pesticidal composition containing eugenol.

Further, the Office Action acknowledges that the '930 patent and JP 07145598 do not teach the use of phenethyl propionate and benzyl alcohol. To address this deficiency, the Office Action asserts that the '767 patent teaches the use of benzyl alcohol and eugenol in the pesticidal compositions that kill household pests and that the '584 patent teaches adding phenethyl propionate into the formulation with eugenol for *attracting* household pests or insects. The Office Action states that Ngoh teaches the killing effect of eugenol and other plant derived benzene derivatives via contact with household pests and concludes that it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add phenethyl propionate, benzyl alcohol and/or eugenol to the pesticidal compositions comprising rosemary oil and peppermint oil because one of skill in the art would have been motivated to add benzyl alcohol and/or eugenol for the expected benefit of killing household pests. In response, Applicant respectfully submits that none of the pending claims recite a pesticidal composition containing eugenol.

In view of the above, Applicant respectfully submits that the rejections under 35 U.S.C. § 103(a) should be reconsidered and withdrawn.

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### **DOUBLE PATENTING REJECTION**

The Office Action rejects claims 4, 19 and 45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of the '930 patent. In response, U.S. Patent No. 6,531,163 does not teach the use of rosemary oil and the deficiencies of the '930 patent teachings are, as noted above. Applicants respectfully submit that alone or improperly combined, the claimed invention, *as amended*, would not have been obvious over U.S. Patent No. 6,531,163 in view of the '930 patent. Thus, reconsideration and withdrawal of this rejection are respectfully requested.

### **CONCLUSION**

If anything further could be done to place the above-captioned patent application in better condition for allowance (i.e., via Examiner's Amendment), then please contact the undersigned attorney at the telephone number listed below.

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Please grant any extension(s) of time deemed necessary for entry of this communication.  
The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. 14-1140.

Respectfully submitted,

NIXON & VANDERHYE P.C.

Date: July 5, 2005

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document (including any paper referred to as being attached or enclosed) is being sent to the U.S. Patent and Trademark Office via facsimile transmission to (703) 872-9308 or (571) 273-8300 on the date indicated below, with a coversheet addressed to Commissioner for Patents, U.S. Patent and Trademark Office.

Date: July 5, 2005

By: Willem F. Gadiano

Willem F. Gadiano, Reg. No. 37,136